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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,941	05/02/2001	Wayne K. Dunshee	56703USA8A.002	6157

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04/26/2004

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EXAMINER

LEWIS, KIM M

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,941

Applicant(s)

DUNSHEE, WAYNE K.

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1-12, 19-22, 24-51, 53, 54, 56 and 57 is/are rejected.
- 7) ☒ Claim(s) 13-18, 52, 55 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Detailed Action.

DETAILED ACTION

Summary

Prosecution of this application has been reopened in light of the newly discovered publication, U.S. Patent Application No. 2002/016446 A1.

Response to Amendment

The amendment and response under 37 CFR 1.116 filed, 3/11/04 has been received and made of record in the application file wrapper.

In response to applicants' request to withdraw the provisional double patenting rejections and permit the application to issue as a patent, the provisional double patenting rejections are no longer the only rejections remaining in the office action. Consequently, the request for allowing this application to issue as a patent is denied.

Drawings

The drawings were received on 3/12/04. These drawings are approved by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-7, 24-27, 37-40, 50, 51, 53, 54, 56, 57 and 59-61 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Application No. 2002/0164446 A1 ("Zhou et al.") in view of U.S. Design Patent D454,956 ("Visintainer").

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

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the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

As regards claim 1, Zhou et al. disclose medical articles, such as bandages (para. 0039 and 0042), comprising a stretch removable pressure sensitive adhesive layer disposed on a backing (para. 0010, 0040, 0041 and para. 0048). Zhou et al. fail to teach that the backing comprises a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees or less.

Visintainer, however, discloses a decorative bandage set comprising the ornamental design of various shaped bandages. Included in the set are triangular and

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square (diamond) shaped bandages. The square (diamond) bandages comprise a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees.

It would have been to one having ordinary skill in the art to provide the bandages of Zhou et al. in any shape in the set disclosed by Visintainer for ornamental purposes.

As regards claim 2, 3 and 5-7, note the figures of Visintainer.

As regards claims 24, 25, 37 and 38, both Zhou et al. and Visintainer fail to teach the claimed setback width and setback distance. It would have been obvious to one having ordinary skill in the art to add these particulars to the modified medical device (bandage) of Zhou et al. since the applicant has not disclosed that these particular dimensions solve any stated problem or are for any particular purpose. Moreover, it appears that the invention would perform equally well with different setback widths and setback distances.

Whether these particulars solve any particular problem or produce any unexpected result, I must conclude that they are merely matters of engineering design choice and thus do not serve to patentably distinguish the claimed invention over the prior art of record. *In re Kuhle*, 526 F.2d 53, 188 USPQ (CCPA 1975).

As regards claims 26, 27, 39 and 40 note the figures of Visintainer.

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As regards claim 59, Zhou et al. disclose medical articles that are produced by applying a stretch removable adhesive to major surface (portion) of the backing layer (para. 39 and para. 40). The same holds true when the modified bandage of Zhou et al., as discussed in the rejection of claim 1 above, is manufactured.

As regards claims 60 and 61, note the rejections of claims 24, 25, 37, 39 and 59.

Claims 4, 8-11, 28-32 and 41-45 are rejected as being obvious over Zhou et al. in view of Visintainer as applied to claim 1 above, and in further view of Curad.

As regards claims 4, 28 and 41, both Zhou et al. and Visintainer fail to teach radiused tips. However, Curad teaches additional ornamental designs of bandages with radiused tips.

It would have been obvious to one having ordinary skill in the art to provide the modified device of Zhou et al. with radiused tips for ornamental purposes.

As regards claim 8, both Zhou et al. and Visintainer fail to teach that the plurality of terminal portions comprises only one pair of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions.

Curad teaches additional ornamental designs of bandage, wherein one of the bandages comprises only one pair of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions.

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As regards claim 9-11, both Zhou et al. and Visintainer fail to teach the claimed bandage configurations. However, Curad also teaches bandages having a plurality of terminal portions, wherein the plurality of terminal portions comprises two or more pairs of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portions and aligned along a common axes extending through the tips of the pair of opposing terminal portions, and further wherein the common axes of two or more pairs of opposing terminal portions are aligned with each other.

Curad further teaches bandages having a plurality of terminal portions, wherein the plurality of terminal portions comprises only two pairs of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions and further wherein the common axes of the two pairs of opposing terminal portions intersect each other within the central portion of the backing, and wherein the common axes are substantially perpendicular.

It would have been obvious to one having ordinary skill in the art to provide the modified bandage of Zhou et al. in the shapes disclosed in Curad for ornamental purposes.

As regards claims 29 and 42, note the rejection of claim 8 above.

As regards claims 30 and 43, note the rejection of claim 9 above.

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As regards claims 31, 32, 33 and 45, note the rejection of claims 10 and 11 above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-7, 12, 24-27, 37-40, 50-51, 53, 54, 56, 57, 59-61 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 30 and 51 of copending Application No. 09/934450 ("the '450 application") in view of Visintainer.

As regards claim 1, claim 17 of the '450 application discloses substantially all features of the claim except a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees or less.

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Visintainer discloses a decorative bandage set comprising the ornamental design of various shaped bandages. Included in the set are triangular and square (diamond) shaped bandages. The square (diamond) bandages comprise a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees.

It would have been to one having ordinary skill in the art to provide the bandages of the '450 application in any shape in the set disclosed by Visintainer for ornamental purposes.

As regards claims 2, 3 and 5-7, note the Figs. of Visintainer.

As regards claim 12, claim 30 of the '450 application discloses the central portion as having a tab.

As regards claims 24, 25, 37 and 38 both the '450 application and Visintainer fail to teach the claimed setback width and setback distance. It would have been an obvious matter of design choice to add these particulars to the modified device of the '450 application since the applicant has not disclosed that these particular dimensions solve any stated problem or are for any particular purpose, and it appears that the invention would perform equally well with different setback widths and setback distances.

Whether these particulars solve any particular problem or produce any unexpected result, I must conclude that they are merely matters of engineering design

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choice, and thus do not serve to patentably distinguish the claimed invention over the prior art of record. *In re Kuhle*, 526 F.2d 53, 188 USPQ (CCPA 1975).

As regards claims 26, 27, 39 and 40, note the Figs. of Visintainer.

As regard claims 50, 51 and 59, claim 51 of the '450 application substantially disclose all features of method claim except a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees or less. Note the double patenting rejection of claim 1 above, which discusses obviousness of the absent feature.

As regards claim 53, 56, 60 and 61, note the rejection of claims 24, 25, 37 and 38 above.

As regards claims 54 and 57, note the double patenting rejection of claims 50 and 51 of the '450 application.

This is a provisional obviousness-type double patenting rejection.

Claims 4, 8-11, 28-32, 41-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of the '450 application in view of Visintainer and Curad.

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As regards claims 4, 28 and 41, both the '450 application and Visintainer fail to teach radiused tips. However, Curad teaches additional ornamental designs of bandages, such bandages have radiused tips.

It would have been obvious to one having ordinary skill in the art to provide the modified device of the '450 application with radiused tips for ornamental purposes.

As regards claim 8, both the '450 application and Visintainer fail to teach that the plurality of terminal portions comprises only one pair of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions.

Curad teaches additional ornamental designs of bandages, wherein, one of the bandages comprises only one pair of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions.

As regards claim 9-11, both the '450 application and Visintainer fail to teach the disclosed bandage configurations. However, Curad also teaches bandages having a plurality of terminal portions, wherein the plurality of terminal portions comprises two or more pairs of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portions and aligned along a common axes extending through the tips of the pair of

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opposing terminal portions, and further wherein the common axes of two or more pairs of opposing terminal portions are aligned with each other.

Curad further teaches bandages having a plurality of terminal portions, wherein the plurality of terminal portions comprises only two pairs of opposing terminal portions, wherein each pair of opposing terminal portions comprises two terminal portions located on opposite sides of the central portion and aligned along a common axis extending through the tips of the pair of opposing terminal portions and further wherein the common axes of the two pairs of opposing terminal portions intersect each other within the central portion of the backing, and wherein the common axes are substantially perpendicular.

It would have been obvious to one having ordinary skill in the art to provide the modified bandage of the '450 application in the shapes disclosed in Curad for ornamental purposes.

As regards the rejection of claims 29 and 42, note the rejection of claim 8.

As regards the rejection of claims 30 and 43, note the rejection of claim 9.

As regards the rejection of claims 31, 32, 44 and 45, note the rejection of claims 10 and 11.

This is a provisional obviousness-type double patenting rejection.

Claims 19-22, 33-36 and 46-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 11, 12, 19 and 28 of copending Application No. 09/847942 ("the '942 application") in view of Visintainer.

As regards claims 19-22, 33-36 and 46-49, claims 11, 12 19 and 28 of the '942 application disclose the claimed adhesive components and backing material (substrate), but fails to teach the shape of the medical article as claimed in claim 19-22, 33-36 and 46-49.

Visintainer discloses a decorative bandage set comprising the ornamental design of various shaped bandages. Included in the set are triangular and square (diamond) shaped bandages. The square (diamond) bandages comprise a plurality of terminal portions extending outwardly from a central portion, wherein each terminal portion of the plurality of terminal portions tapers towards a tip located distal from the central portion, wherein each terminal portion of the plurality of terminal portions comprises two edges leading to the tip, the two edges defining an included angle of about 90 degrees.

It would have been to one having ordinary skill in the art to provide the bandages of the '942 application in any shape in the set disclosed by Visintainer for ornamental purposes.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

Claims 13-18, 52, 55, 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim 23 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest a medical article comprising a predefined tab located within the central portion of the backing, wherein the predefined tab comprises a fold” as per instant claims 13-18 and 23.

The prior art also fails to teach or fairly suggest a method of removing a medical article from the skin comprising the step of “grasping the medical article within the central portion; and stretching the medical article within the central portion to remove the medical article from the skin”. Although the prior art teaches that stretch removable adhesive articles are known, these tapes are generally stretched lengthwise in a direction parallel to the surface to which they are applied (*i.e.*, they are either stretched from one end as disclosed by U.S. Patent No. 4,024,312 or stretched from both ends as disclosed by EP Patent Application No. 0 747 027 A2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703.308.0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
April 23, 2004